

REMARKS

Claims 25, 27, and 45-71 were pending. Claim 71 is canceled herein. Claims 25, 27, and 45-70 are currently pending. No claim has been allowed.

Formal Matters

Applicants gratefully acknowledge the entry of the Amendment and Declaration filed on March 11, 2004, and the acceptance of the Sequence Listing the substitute Declaration.

Applicants also gratefully acknowledge the withdrawal of the rejection under 35 U.S.C. § 102 (b) of record.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claim 71 is rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. According to the Examiner, the specification as originally filed refers to the compound only as EST. The Examiner asserts that EST is not a term of art. Applicants traverse this rejection.

Applicants have canceled claim 71 herein, and therefore this rejection is rendered moot.

Therefore, Applicants respectfully submit that this basis of the rejection may be removed.

Rejection Under the Judicially-Created Doctrine of Obviousness-Type Double Patenting

Claims 25, 27, and 45-71 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 and 7-13 U.S. Patent No. 6,410,512. According to the Examiner, the claims are not patentably distinct from each because both application claim PS1 for the same function, but the present application broadly includes additional compounds. Claims 25, 27, and 45-71 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 of the co-pending Application No. 10/050,425. The Examiner asserts that the conflicting claims are not identical, but are not patentably distinct from each other because the claims of the '425 patent also include inhibiting NF-κB. Applicants traverse this rejection.

Applicants include herein terminal disclaimers under 37 C.F.R. § 1.321 for U.S. Patent No. 6,410,512 and in anticipation of the issuance, for U.S. Application Serial No. 10/050,425, filed January 15, 2002. However, Applicants note that the '512 patent does not have 13 claims, and therefore assume that the basis of the rejection lies in claims 1-6, and correspondingly, that the basis for rejection based on the co-pending Application No. 10/050,425 lies in claims 1 and 7-13 as claims 2-6 are not pending in that application. Applicants also note that claims of the '425 application pending at the time of the instant Action did not include inhibitors of NF-κB. Nonetheless, in view of the submitted terminal disclaimers, the rejection is rendered moot.

Therefore, Applicants respectfully submit that this basis of the rejection may be removed.

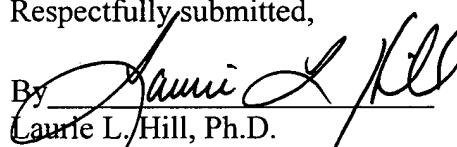
CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 432722002612. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: April 9, 2004

Respectfully submitted,

By 
Laurie L. Hill, Ph.D.

Registration No.: 51,804
MORRISON & FOERSTER LLP
3811 Valley Centre Drive, Suite 500
San Diego, California 92130
(858) 720-7955